

REMARKS

The Office Action mailed on September 11, 2003, has been reviewed and the comments of the Patent and Trademark Office have been considered. Prior to this paper, claims 1-22 were pending in the present application. Claims 23-28 have been added and claims 18, 19, 21, and 22 been cancelled without prejudice or disclaimer. Therefore, claims 1-4, 6-17, and 23-29 are now pending in the present application, with claims 9-16 and 23-29 under current consideration on the merits (claims 1-4, 6-8 and 17 are currently withdrawn).

A request for continued examination is being filed concurrently with this response to have the above amendments to the claim set entered.

Applicants respectfully submit that the present application is in condition for allowance for the reasons that follow.

Specification Objections

In the Office Action, the specification was objected to under 35 U.S.C. § 132 as introducing new matter into the disclosure of the invention. Specifically, the Office Action identifies the addition of the statement "electric resistance weld tube A" in reference to Figure 17 as not being supported by the original disclosure. In response, Applicants point to the "Brief Description of the Drawings" section, which states that (on page 3), "Fig. 17 is a cross section of an electric resistance weld tube," and respectfully submit that this statement sufficiently provides support for the objected to specification amendment. Applicants respectfully request reconsideration of this objection.

Claim Rejections Under 35 U.S.C. § 103(a)

In the Office Action, claims 18-19 and 21-22 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Japan 6-99870 in view of Japan 5-65076, and

claims 9-16 are rejected under the same statute as being unpatentable in over Japan 61-291272 in view of Japan 6-99870. As seen above, Applicants have cancelled claims 18-19 and 21-22 without prejudice or disclaimer, and amended independent claim 9. Applicants respectfully traverse the rejection of claim 9 and the claims that depend from claim 9, and submit that these claims are allowable for at least the following reasons.

Applicants rely on MPEP § 2143, which states that:

[t]o establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations.

It is respectfully submitted that at least the first and third criteria of MPEP § 2143 have not been met in the Office Action.

Lack of Suggestion or Motivation to Modify or Combine the References

MPEP § 2143.01 states that "the prior art *must* suggest the desirability of the invention." (MPEP § 2143.01, subsection 1, emphasis added.) The Office Action appears to rely solely on the Applicants' disclosure for motivation to modify the reference to arrive at the invention of claim 9. There is nothing in the either of the references that suggests the desirability of Applicants' invention, and the Office Action does not provide evidence that motivation to modify and/or combine those references is in the knowledge generally available to one of ordinary skill in the art. The Office Action simply relies on an argument that "it would have been obvious to . . . modify Japanese '272 to include monolithic thick and thin portion side walls as taught by Japanese '870 in order to extrude the side frames (English Abstract) and hence

simplify production (claim 9).” (Office Action, page 5, lines 3-6.)

In regard to the “desire” to “extrude the side frames,” Applicants respectfully submit that one of ordinary skill in the art would not modify Japan ‘272 simply to “extrude side frames.” In fact, one of ordinary skill in the art would avoid extruding side beams, as one of ordinary skill would view it as simpler to take two elongated sheets of metal and bend the sheets to form two “C” beams, and weld (or, alternatively, simply mechanically fasten) the “C” beams together, as is done in Japan ‘272. Still further, assuming *arguendo* that it would be desirable “to extrude side frames,” Applicants submit that the mere desire to do so would still not result in motivation to modify Japan ‘272 to arrive at the present invention. **Indeed, it is not clear that the beams of Japan ‘272 are not already extruded.** It is entirely possible that the teachings of Japan ‘272 are implemented by extruding two “C” beams that are later inscribed and welded together. Thus, the mere desire to use extruded beams would still not result in a motivation to modify Japan ‘272 to use a monolithic beam as proffered in the Office Action. Such modification would be inventive, not obvious.

As to the “desire” to “simplify production,” it is well known that reducing aluminum to a semi-molten state, such as would be required to extrude aluminum, is energy intensive, dangerous due to the high temperatures involved, and requires the fabrication of precise extrusion dies that are limited to the use of making a specific beam. Thus, Applicants submit that utilizing extruded beams would not necessarily “simplify production,” and a *prima facie* case of obviousness has not been established.¹

The Office Action asserts that the welded panels 11 and 12 of Japan ‘272 “could be considered to make a solid an uniform or monolithic structure.” (Office

¹ MPEP § 2143.01, states that obviousness “can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either explicitly or implicitly in the references themselves or in the knowledge generally available to one of ordinary skill in the art. ‘The test for an implicit showing is what the combined teachings, knowledge of one of ordinary skill in the art, and the nature of the problem to be solved as a whole would have suggested to those of ordinary skill in the art.’” (Citations omitted.)

Action, sentence spanning pages 4 and 5.) That is, as best understood, the Office Action asserts that the meaning of "monolithic" could be construed as covering the panels of Japan '272. As seen above, Applicants have made the above clarifying amendment to claim 9 to make clear that the thin and thick walled portions are free from inscribed mating, in contrast panel 12 being inside panel 11, as shown in Figs. 1, 3 and 5 of Japan '272. Thus, on this point alone, Japan '272 teaches away from the present invention for at least these reasons.

Yet further, the statement that members 1 and 2 could be considered monolithic is factually incorrect. The asserted thinner wall portions are plainly shown as different portions, and are shown as connected to the asserted thicker wall portions. The single piece, or monolithic structure claimed simply is not present in Japan '272. The members 1 and 2 are separate pieces. Nonetheless, Applicants amended claim 9 to recite that the thin wall portion is free from inscribed mating with the thick wall portion.

Further, MPEP § 2143.01, subsection 6 states that "the proposed modification cannot change the principle of operation of a reference – If the proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims *prima facie* obvious. *In re Ratti*, 270 F.2d 810 (CCPA 1959)." In *Ratti*, the CCPA held that the "suggested combination of references would require a substantial reconstruction and redesign of the elements shown in the primary reference." This substantial redesign would have resulted in changing a rigid seal to a resilient seal. Thus, a reference cannot be modified if the modification changes the principle of operation of the reference.

With the above in mind, it is respectfully submitted that since Japan '272 teaches that as a principle of operation, its panels are inscribed with one another and welded together, substituting the beam of Japan '870 with the beam of Japan '272 would change the principle of operation of Japan '272, thus rendering the modification un-obvious. Since modifying Japan '272 to utilize a monolithic beam free from inscription, "the teachings of [Japan '272] are not sufficient to render the claims *prima facie* obvious."

The Cited References Do Not Suggest All Claim Recitations

Even if the first requirement of MPEP § 2143 was satisfied in the Office Action (which it is not, as seen above), the cited references still do not meet the third requirement, which is that “the prior art reference (or references when combined) must teach or suggest all the claim limitations.”

For example, claim 13 recites structural details such as an “eccentric pipe” having an “inner cylindrical surface” and an “outer cylindrical surface,” where the center of the inner cylindrical surface is eccentric from the center of the outer cylindrical surface.” The cited references do not teach or suggest such recitations. The Office Action relies on the argument that “the shape of the pipe that is eventually formed into the side member is not patentably distinguishing in an article claim,” and thus fails to substantively address the deficiencies of the reference in view of claim 13.

Applicants have removed the alleged process language from these claims, and respectfully submit that these claims are allowable, as neither Japan '272 nor Japan '870 disclose or suggest such recitations.²

In sum, even if the first requirement of MPEP § 2143 is satisfied, the third requirement of MPEP § 2143 is not satisfied in the Office Action, since the cited art does not teach each and every element of the present invention. Thus, the present claims are allowable.

New Claims

As seen above, Applicants have added new claims 23-29. Support for the new claims can be found, among other places, in the figures. These claims are allowable due to their dependency from claim 9, which, as seen above, is allowable, and due to

² Applicants submit that the recitations related to the extruded material, such as “extruded sections,” impart structural recitations, as a mechanical engineer would recognize that extruded members are structurally different from, for example, forged or stamped members.

the fact that these claims recite additional recitations that are not present in the cited references.

Conclusion

Applicants believe that the present application is in condition for allowance, and favorable reconsideration is requested.

If Applicants have not accounted for any fees required by this Amendment, the Commissioner is hereby authorized to charge to Deposit Account No. 19-0741. If Applicants have not accounted for a required extension of time under 37 C.F.R. § 1.136, that extension is requested and the corresponding fee should be charged to our Deposit Account.

Examiner Culbreth is invited to contact the undersigned by telephone if it is felt that a telephone interview would advance the prosecution of the present application.

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Respectfully submitted,

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